



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/583,445

05/30/2000

E. Barton Manchester

062891.0390

1676

5073

7590

03/10/2006

BAKER BOTTS L.L.P.

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

EXAMINER

PEYTON, TAMMARA R

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,445

Applicant(s)

MANCHESTER, E. BARTON

Examiner

Tammara R Peyton

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-13, 17-21 and 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over *Chieng et al.*, (US 6,035,346) and *Saphar et al.*, (US 6,669,096).

As per claim 1, 2, 11, 12, 18, 19, and 26-28, *Chieng* teaches a method for automatically placing the card in a reset state (via reset register, 525) in response to an activation (selection) of a card in a network element comprising one or more switch (adapter) cards, the method comprising:

in response to placing the card in hold or wait mode:
communication a signal indicating a type of the card (obvious);
retrieving an executable file stored remotely (host processor) from the card and switch (adapter) cards based at least in part on the type of the card,;
downloading the executable file to a memory (515/520, Fig. 5 or 810/815, Fig. 8) for a processor (510 or 805) on the card without requiring the use of boot code on the card; and removing the card from the hold or wait state and operating the card using the executable file. (Abstract, col. 2, lines 47-col. 6, lines 1-20)

Chieng teaches a method of placing the card in a reset mode (via reset register, 525) in response to selection of a card and determining a type of card and retrieving an executable file stored on a remote memory (110, Fig.5) and downloading the executable file to the card's memory (515/520, Fig. 5 or 810/815, Fig. 8) without using boot code on the card because the card is put into a hold state during the download. *Chieng* does not expressly teach of the card being a switch card, however, one of ordinary skill would readily recognize that *Chieng* would have motivate to implement a host of other types of cards using *Chieng's* system because doing so would add and expand the flexibility of *Chieng* without departing from the inventive concept. *Chieng* teaches placing the card in reset mode upon activation of the card and is silent in respect to placing the card in reset mode upon a power up, nonetheless, Saphar teaches a method of placing a card in reset mode during power up. Specifically, Saphar teaches detecting the presence of a card, powering (reset) the card, and performing particular acts on the card upon being powered up, including waiting for a response to the reset by the card that includes the card providing a specific code that will inform the system of the type of card being powered up. (Saphar, cols. 4-7, Fig.4)

It would have been obvious to one of ordinary skill at the time the invention was made to implement Saphar's method of detecting the presence of a card, powering (reset) the card, and performing particular acts on the card upon being powered up because doing so would allow easier recognition and authentication of the type of card

Art Unit: 2182

so that communication can be continued in accordance with a given communication protocol. (Saphar, col. 5, lines 12-23)

As per claim 3, 13, 20, 21, and 29-31, *Chieng* teaches holding/suspending the processor while downloading the executable file and releasing the processor subsequent to the download.

As per claims 8-10, and 17, *Chieng* does not expressly teach a dedicated download card, however, one of ordinary skill would readily recognize that *Chieng's* host processor teaches retrieving and downloading the appropriate executable file based on the inserted card. Further, as for the card transmitting a present or reset message to host processor, *Chieng* teaches the processor recognizing an inserted card, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the card would transmit a signal alerting the host processor to its present in the system. Therefore, Examiner is taking the position that *Chieng* teaches the steps normally performed by a dedicated download card.

Claims 4-7, 14-16, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chieng et al.*, (US 6,035,346) and *Saphar et al.*, (US 6,669,096) and in further view of *Berenbaum et al.*, (US 6,272,144)

As per claims 4-7, 14-16, and 22-25, *Chieng-Saphar* does not expressly teach a card comprising a field-programmable gate array (FPGA). However, *Berenbaum* teaches a line card comprising a FPGA (*Berenbaum*, 104, Fig. 8) is well known in the art. Therefore, it would have been obvious to one of ordinary skill that it would not be out of the scope of *Chieng-Saphar* card to implement a FPGA as described in *Berenbaum*, because doing so would control the transmission protocol of the line card. (*Berenbaum*, col. 7, lines 25-39)

Response to Applicant's Arguments

Applicant argues that Examiner's statement that "*Chieng* would have motivate to implement a host of other types of cards using *Chieng*'s system because doing so would add and expand the flexibility of *Chieng* without departing from the inventive concept," does not provide motivation as to why *Chieng* would have been motivation to implement other types of cards." *Chieng* teaches a system that uses adapter cards wherein the adapter card is automatically placed in a reset state (via reset register, 525) in response to an activation (selection) of a adapter card in a network element comprising one or more adapter cards, and in response to placing the adapter card in hold or wait mode: communicating a signal indicating a type of the card (obvious); retrieving an executable file stored remotely (host processor) from the card and switch (adapter) cards based at least in part on the type of the card and downloading the executable file to a memory for a processor on the card without requiring the use of boot code on the card; and removing the card from the hold or wait state and operating

the card using the executable file. Examiner is taking the position that *Chieng's* inventive concept teaches the method in which a card in the network is placed in a reset mode and the method in which Applicant claims these steps. Therefore, using the inventive concept of *Chieng* Examiner does not understand why Applicant believes that *Chieng* would not have been motivated to implement other types of cards that perform at least part of the method steps claimed by Applicant. As to Applicant's argument to why *Chieng* would have been motivated to implement *Saphar's* method of detecting the presence of a card, powering (reset) the card, and performing particular acts on the card upon being powered, Examiner is taking the position that *Saphar's* method would allow easier recognition and authentication of the type of card; and, because *Chieng* specifically teaches performing a function for the card in the network based at least in part on the type of card - *Saphar's* method would further allow communication to can be continued in accordance with a given communication protocol based on the easier recognition. (*Saphar*, col. 5, lines 12-23)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant's arguments are moot based on the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

Application/Control Number: 09/583,445
Art Unit: 2182

Page 8

(571) 273-8300

Hand-delivered responses should be brought to:

USTPO, Randolph Building, Customer Service Window

401 Dulany Street

Alexandria, VA 22314.

**TAMMARA PEYTON
PRIMARY EXAMINER**

A handwritten signature in cursive script, appearing to read 'Tammara Peyton', written in black ink.

Tammara Peyton

March 1, 2006